

### **REMARKS**

In response to the final Office Action dated 12 January 2006, the applicants request reconsideration of the above-identified application in view of the following remarks. Claims 1-14, 16-18, 28-31, 33-44, and 49 are pending in the application, and are rejected. None of the claims are amended.

#### **Interview Summary**

The applicants thank Supervisory Patent Examiner Perveen for the telephone interview granted on Tuesday, March 21, 2006 between herself and the applicant's representative Mr. Mates (Reg. No. 35,271). The rejections of the pending claims were discussed, and no agreement was reached. The substance of this response was discussed during the interview.

#### **Rejections of Claims Under §103**

A. Claims 1-14, 16-18, 28-31, 33-34, 36-44, and 49 were rejected under 35 USC § 103(a) as being unpatentable over Baker (U.S. 6,333,938) in view of Earnest (U.S. 6,226,338). The applicants respectfully traverse.

Baker issued on December 25, 2001, which is after the filing date of the present application. The applicant does not admit that Baker is prior art, and reserves the right to swear behind Baker at a later date.

Earnest issued on May 1, 2001, which is less than one year before the filing date of the present application. The applicant does not admit that Earnest is prior art, and reserves the right to swear behind Earnest at a later date.

The MPEP requires a suggestion and a reasonable expectation of success for a rejection under 35 USC § 103:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."<sup>1</sup>

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<sup>1</sup> MPEP 2143.

The suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art.<sup>2</sup>

Baker relates to a PCI-interface device.<sup>3</sup> Baker shows in Figure 2 “the functional partitioning of PCI-interface ASIC 20.”<sup>4</sup> Baker shows and describes the PCI-interface ASIC 20 in detail.<sup>5</sup>

Earnest relates to a “multiple-channel data communication buffer” that “includes a transmit first-in-first-out (“FIFO”) circuit and a receive FIFO circuit.”<sup>6</sup> Earnest describes a receive FIFO 18 in detail,<sup>7</sup> and the final Office Action proposes to add the “FULL” flag of the receive FIFO 18 of Earnest<sup>8</sup> to the PCI-interface ASIC 20 of Baker.

The final Office Action has not shown evidence from the prior art of a suggestion to one skilled in the art to combine Baker and Earnest, and has not shown evidence of a reasonable expectation of success.

*No Evidence of a Suggestion or Motivation to Combine*

The final Office Action states:

“Baker does not specifically disclose a stop message channel coupled to the receive control block and adapted to send a stop message to a source when a receive FIFO reaches a stop threshold value....it would have been obvious to include the stop message channel, as disclosed by Earnest, in the system of Baker, since this would prevent the writing of data in FIFO that has no more room for data.”<sup>9</sup>

Similar statements are made in other parts of the rejection.<sup>10</sup> The final Office Action has not identified prior art as being the source of the above-quoted rationale for combining Baker and the buffer of Earnest as is required by MPEP 2143. The devices and methods described in

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<sup>2</sup> MPEP 2143.

<sup>3</sup> Baker, Abstract.

<sup>4</sup> Baker, column 5, lines 66-67.

<sup>5</sup> Baker, column 5, line 66 to column 13, line 15.

<sup>6</sup> Earnest, Abstract.

<sup>7</sup> Earnest, column 9, line 37, to column 11, line 55.

<sup>8</sup> Earnest, column 11, lines 40-45.

<sup>9</sup> Final Office Action, page 3.

<sup>10</sup> Final Office Action, pages 6-7, 8, and 10-11.

Baker are specifically directed to extracting control information from packetized data in an IEEE 1394 standard or similar PCI interface device.<sup>11</sup> The final Office Action has not shown why a skilled person would be motivated to modify the system of Baker that complies with IEEE 1394. The final Office Action has not shown evidence that the system of Baker that is compliant with IEEE 1394 is deficient in a way that can be remedied by addition of the “FULL” flag of the receive FIFO 18 of Earnest.

*No Evidence of a Reasonable Expectation of Success*

The final Office Action also lacks evidence from the prior art of a reasonable expectation of success of this combination of Baker and Earnest as required by MPEP 2143. The final Office Action has not shown where the “FULL” flag of the receive FIFO 18 of Earnest is to be added to the system of Baker. Baker describes the PCI-interface ASIC 20 in detail as noted above, and the final Office Action has not shown where in the detailed ASIC 20 of Baker the “FULL” flag of the receive FIFO 18 of Earnest is to be added. The PCI-interface ASIC 20 of Baker complies with IEEE 1394.<sup>12</sup> The final Office Action has not shown that the buffer of Earnest is compliant with IEEE 1394. The final Office Action has not shown how the system of Baker that is compliant with IEEE 1394 can be modified by elements of Earnest and still maintain compliance with IEEE 1394.

*Traverse of Official Notice*

The final Office Action states:

“Official Notice is being taken that advantages of power management are well known in the art and it would have been obvious to include a power management unit in the system of Baker since this would allow power to be saved.”<sup>13</sup>

The applicants respectfully traverse this assertion of official notice. Official notice is taken of supposed “advantages of power management.” The final Office Action appears to be

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<sup>11</sup> Baker, column 3, lines 5-11.

<sup>12</sup> Baker, column 5, lines 27-35.

<sup>13</sup> Final Office Action, page 4.

taking official notice of the scope and content of the prior art, or is taking official notice that a claimed feature is obvious. In either case, official notice cannot be used to establish the scope and content of the prior art, or the obviousness of a claimed feature. Obviousness can only be established by showing all of the elements in MPEP 2143.

Official notice should only be used where the facts asserted are capable of instant and unquestionable demonstration:

“the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute.’”<sup>14</sup>

The “state of the art” is not an appropriate subject of official notice:

“[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amendable to the taking of such notice.”<sup>15</sup>

Official notice should rarely be used in a final Office Action:

“While ‘official notice’ may be relied on, these circumstances should be rare when an application is under final rejection.”<sup>16</sup>

MPEP 2144.03 cites both *In re Zurko* and *In re Lee* requiring that rejections be based on evidence of record.<sup>17</sup>

The applicants respectfully submit that the official notice taken in the final Office Action is improper under MPEP 2144.03, should be withdrawn, and that the affected claims are in condition for allowance.

### *Rejection of Claim 34 Does Not Make Prima Facie Showing of Obviousness*

Claim 34 was rejected with the following sentence:

“Regarding claim 34, Baker does not disclose the predetermined algorithm is round-robin. However, the round-robin algorithm is a well-

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<sup>14</sup> MPEP 2144.03 quoting *In re Ahlert*, 165 USPQ 418, 420 (CCPA 1970).

<sup>15</sup> MPEP 2144.03 quoting *In re Eynde*, 178 USPQ 470, 474 (CCPA 1973).

<sup>16</sup> MPEP 2144.03

<sup>17</sup> *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001); *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

known arbitration scheme and therefore could be substituted for the arbitration scheme in Baker's system."<sup>18</sup>

This rejection of claim 34 establishes that Baker is missing the "round-robin" feature, but does not point to any prior art with the feature. None of the elements of a *prima facie* case of obviousness of MPEP 2143 are established in this rejection. The applicants respectfully request that a prior art reference be added to the rejection showing the features missing in Baker, or that the rejection of claim 34 be withdrawn.

### *Conclusion*

The final Office Action has not presented prior art showing a suggestion for, or a reasonable expectation of success of, this combination of Baker and Earnest as is required by MPEP 2143.

The applicants respectfully submit that a *prima facie* case of obviousness against claims 1-14, 16-18, 28-31, 33-34, 36-44, and 49 has not been established in the final Office Action, and that claims 1-14, 16-18, 28-31, 33-34, 36-44, and 49 are in condition for allowance.

B. Claim 35 was rejected under 35 USC § 103(a) as being unpatentable over Baker, in view of Earnest and Holm et al. (U.S. 6,122,680, Holm). The applicants respectfully traverse.

Holm relates to a "multiple channel data communication buffer."<sup>19</sup> The final Office Action states:

"it would have been obvious to use the teachings of Holm in the system of Baker and Earnest, to use a bus with varying width since this would increase compatibility."<sup>20</sup>

The final Office Action has not identified prior art as being the source of the above-quoted rationale for combining Baker, Earnest, and Holm as is required by MPEP 2143. The final Office Action has not presented prior art showing a reasonable expectation of success of such an arrangement.

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<sup>18</sup> Final Office Action, page 7.

<sup>19</sup> Holm, Abstract.

<sup>20</sup> Final Office Action, page 11.

The applicants respectfully submit that a *prima facie* case of obviousness against claim 35 has not been established in the final Office Action, and that claim 35 is in condition for allowance.

### CONCLUSION

The applicants respectfully submit that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,


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